

BS00403

U.S. Application No. 09/892,474 Examiner NGUYEN BA, Art Unit 2176
Request for Reconsideration in Response to First Office Action

REMARKS

In response to the Office Action dated August 13, 2004, Assignee respectfully requests reconsideration based on the following remarks. Assignee respectfully submits that the pending claims are in a condition for allowance.

The United States Patent and Trademark Office (the "Office") rejected claims 1-28 under 35 U.S.C. § 103 (a) as being obvious in view of published U.S. Patent Application 2002/0111842 to Miles. The Assignee shows, however, that the Examiner's *prima facie* case for obviousness must fail and that the pending claims are patentably distinguishable over *Miles*. The Assignee thus respectfully submits that the pending claims are ready for allowance.

Amendment to Claims 1, 12, 14, 18, & 23

Claims 1, 12, 14, 18, and 23 have been amended. These claims, however, are NOT amended to overcome prior art. Claims 1, 12, 14, and 18 are amended to cure grammatical errors in the original presentation. Claim 23 has been amended to incorporate now-canceled claim 26 and, thus, does not present a new grounds for rejection.

Rejection of Claims 1-28 under 35 U.S.C. § 103 (a)

Claims 1-28 were rejected under 35 U.S.C. § 103 (a) as being obvious in view of published U.S. Patent Application 2002/0111842 to Miles. If the Office wishes to establish a *prima facie* case of obviousness, three criteria must be met: 1) the Examiner must identify "some suggestion or motivation...to modify the reference"; 2) the Examiner must identify "a reasonable expectation of success"; and 3) "the prior art reference must teach or suggest all the claim limitations." DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition) (hereinafter "M.P.E.P."). The Examiner bears the initial burden of factually supporting any *prima facie* case of obviousness. See *id.* at § 2142. "If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to

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submit evidence of nonobviousness.” *Id.* (emphasis added). Only when the Examiner makes a *prima facie* case does the burden shift to the applicant to present evidence of nonobviousness. See *id.* (emphasis added). Because the Examiner admits that the patent to *Miles* does not teach all the features of the pending independent claims, the *prima facie* case of obviousness must fail. The Assignee thus respectfully requests that a Notice of Allowability issue.

Independent claims 1, 8, 14, 18, and 23 are not obvious in view of *Miles*. Independent claim 1, for example, includes features for “allocating to each engineer a pre-determined number of priorities for a pre-determined number of priority levels.” Independent claims 8, 14, 18, and 23 include a similar feature. The patent to *Miles* is completely silent to at least this claim feature. Examiner Nguyen Ba is correct — *Miles* does show graphical user interface screenshots that have a traditional “High, Medium, and Low” priority levels (see, e.g., FIGS. 94, 95, 101, 102, and 103). *Miles*, however, fails to contemplate that engineers can be allocated a certain number of priorities for each priority level. Because *Miles* fails to teach or even suggest this feature, *Miles* cannot obviate the pending claims and the *prima facie* case of obviousness must fail.

Examiner Nguyen Ba even admits that *Miles* fails to teach all the claim features. Examiner Nguyen Ba admits, at page 3, lines 14-15 of the Office Action, that “*Miles* does not specifically teach allocating a pre-determined number of priorities for a pre-determined number of priority levels.” Examiner Nguyen Ba references and/or makes this same admission when constructing the *prima facie* case for claims 6, 7, 8, 12, 13, 14, 16, 25, and 26. As this response explains above, *Miles* does show traditional “High, Medium, and Low” priority levels (see, e.g., FIGS. 94, 95, 101, 102, and 103). *Miles*, however, fails to contemplate that engineers can be allocated a certain number of priorities for each priority level. One of ordinary skill in the art, then, would not find it obvious to modify the teachings of *Miles* to “allocate to each engineer a pre-determined number of priorities for a pre-determined number of priority levels.” Because *Miles* does not teach or suggest all the claim limitations, *Miles* cannot obviate the claims of

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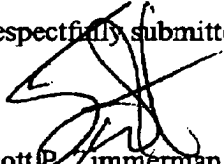
this application. *Miles*, then, cannot support the Examiner's *prima facie* case of obviousness, and the Examiner is required to remove the rejection.

The Office has failed to satisfy their burden. As the M.P.E.P. makes very clear, "If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness." M.P.E.P., § 2143 (emphasis added). Only when the Examiner makes a *prima facie* case does the burden shift to the applicant to present evidence of nonobviousness. *See id.* (emphasis added). As the Assignee has repeatedly explained, the Examiner has the initial burden of showing that all claim limitations are taught. As the Assignee states herein, and as Examiner Nguyen Ba admits in the office action, *Miles* does not teach all the claim limitations. The Examiner has failed to satisfy the burden, and the Examiner is required to remove the rejection.

For at least the foregoing reasons, the Office has failed to satisfy its burden. The pending claims 1-28 are patentably distinguishable over *Miles*. The Assignee thus respectfully requests that Examiner Nguyen Ba remove the § 103 rejection and issue a Notice of Allowance.

If any issues remain outstanding, the Office is requested to contact the undersigned at (919) 387-6907 or scott@scottzimmerman.com.

Respectfully submitted,



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